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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,495	10/31/2000	Allen Louis Gorin	112233-CONT 2	8836

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EXAMINER
PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/699,495	GORIN ET AL.	
	Examiner	Art Unit	
	Joseph T Phan	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

> *The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See Transco Products, Inc. v. Performance Contracting, Inc., 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994).*

More specifically, after brief review, the subject matter of non-verbal speech in the independent claims of the present invention and the subject matter of multimodal form of pages 4 and 5 in the disclosure of the present application are not disclosed in the parent application. Therefore new subject matter is disclosed in the present application and cannot claim the priority date over the parent application.

Specification

2. The attempt to incorporate subject matter into this application by reference to "On automated language acquisition, J.Acoust. Soc. Am., 97 3441-3461, (June 1995) [hereafter referred to as Gorin 95]" on page 5 of applicant's present disclosure and also by reference to "Spoken Language Acquistion for Automated Call Routing....[hereafter Gorin 94A] on page 6 of present disclosure are both improper

because the information and pages as cited toward the reference on pages 5 and 6 are not found within the disclosure. It is not known if the references are a publication, article, or textbook to be located.

The independent claimed subject matter also pertains to information (i.e. non-verbal and multimodal inputs) pointed towards these references.

Appropriate correction is required to continue further with the examination and search process.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-54 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically in independent claims 1 and 28, the specification does not described the generation of meaningful phrases from verbal and non-verbal speech in line 4. It merely points toward an an improper incorporation of a reference with improper usage (eg. "See page numbers" on page 6 lines 4 and 8 of specification). The generation of meaningful phrases from verbal and non-verbal speech must be taught in the disclosed specification.

Additionally, the dependent claims also contain subject matter that the specification does not described in such a way to enable one skilled in the art to make and/or use the invention (e.g. Dependent claim 2 discloses phrases that are expressed in multimodal form, the specification does not disclose phrases expressed in multiple forms, and dependent claim 5 discloses non-verbal speech as one of gestures, body movements, cable box entries, etc. which is not taught by the specification.)

Claim 8 discloses focus of attention which can include eye movement, body position, etc., it is not known what is described by user's focus of attention.

Claim 14 discloses operating within the internet, cable TV network, or wireless network, etc.)

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6, 17-18, 27, 28, 31, 33, 44-45 and 54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "non-verbal speech" in claims 1, 4, 6, 27, 28, 31, 33, and 54 is unclear and confusing which renders the claim indefinite. The specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "multimodal" in claims 2, 3, 29, and 30 is a relative term which renders the claim indefinite. The term "multimodal" is not defined by the claim.
The specification does not provide a standard for ascertaining the requisite degree. Appropriate correction is required.

The phrases "measure of usefulness" in claims 17 and 44 line 3 and "salience measure" in claims 18 and 45 line 2 are unclear and confusing. The measuring method is unclear and not known if there are equations which are measured against or any other method of measuring. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-54 rejected under 35 U.S.C. 103(a) as being unpatentable over Gorin et al., publication "Automated Call Routing in a Telecommunciations Network", 2nd IEEE workshop on Interactive Voice Technology for Telecommunications Applications, Kyoto Research Park, Kyoto, Japan, September 26-27, 1994 pages 137-140 in view of Blattner et al., "Multimedia Interface Design", ACM Press, New York, New York, 1992.

Regarding independent claims 1 and 28, Gorin et al, teaches means for determining a plurality of meaningful phrases from verbal speech each of the meaningful phrases being generated based on one of a predetermined set of the task

objectives (page 138 co1. paragraphs 2 and 3);

a recognizer that recognizes at least one of the meaningful phrases in an input communication of the user (page 138 Fig.2 phrase detector based on input communication of a user and page 138 col.1 paragraph 3, spoken input);

a task classifier that makes a classification decision in response to the recognized meaningful phrases relating to one of the set of predetermined task objectives (page 137, col.1 paragraph 2, *'appropriate action is to connect to an automated subsystem'*);

a task router that routes the user's request in order to perform at least one of the task objectives based on the classification decision (page 137, paragraph 2, *'the machine needs to understand the spoken language to route the call appropriately'*).

Gorin does not expressly disclose input recognition from non-verbal speech.

Blattner teaches, as best understood due to the 112 problems above, input recognition from non-verbal speech (pages 133-135, sections 8.5, 8.5.1 and 8.5.2)

At the time the invention was made, it would have been obvious to a person or ordinary skill in the art to use non-verbal speech(e.g. gestures) as input recognition for routing systems. One of ordinary skill in the art would have been motivated to do this as Blattner discloses using gesture interpretation (eg. eye movements as stated in claim 5 of applicant's present invention) for input recognition (Blattner page 134 paragraph 1). This would allow a user to use multiple forms of input communications and not based only on speech input.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-55 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of Gorin et al, U.S. Patent No. 5,675,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are similar to the ones in patent # 5,675,707.

For example, claims 1 and 28 of the present is the same as claim 31 of the patent except for the patent states 'determining a plurality of meaningful phrases from a set of speech utterances" and the present application states means for "generating a plurality of meaningful phrases from verbal and non-verbal speech" which has been rejected above by failing to provide enablement of said generation of meaningful phrases from verbal and non-verbal input. Therefore, the rejected claims 1 and 28 of the present application is similar to claim 31 of the patent and not patentably distinct.

Claim 55 is not patentably distinct from claim 31 of the patent because it is broader than claim 31 of the patent, In re Van Ornum and Stang, 214 USPQ T61, broad

claims in the continuation application are rejected as obvious double-patenting over previously patented narrower claims. Claim 55 of the present is the same as claim 31 of the patent except that claim 31 adds further limitation of determining a plurality of meaningful phrases from a set of speech utterances....Therefore, claim 55 of the present application is broader than claim 31.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 8:30-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

JTP
November 4, 2002

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600